

REMARKS

The Office Action of July 20, 2001 rejects the sole claim in the application, Claim 27.

Applicant has added new claim Claim 28 so as to further overcome the rejection by the Examiner based on the Paint Pop sales literature upon which the Examiner relies. The following comments apply to Claim 27 as previously submitted and new Claim 28, essentially rebutting the arguments of the Examiner.

The Examiner has stated that the Paint Pop product "displays a similar concept as the claimed product." Certainly the Examiner is not suggesting that "similarity of concept" is a test for patentability. No such support could ever be found in 35 U.S.C. §§ 102 or 103. There are literally thousands of inventions which employ a similar concept that have been patented because that is not the test of invention and because the term "similar concept" is not informed by any case law or statutory interpretation. Similar concept could be construed to include an airplane with a hot air balloon -- they both traverse the earth without touching the ground except upon takeoff and landing!

The Examiner goes on to state that the two products differ only in shape. That is also true about the hot air balloon and the airplane. It is the pejorative use of "only" in that phrase that is objectionable and renders it incorrect. It is precisely because of the difference in shape that the four components making up the confectionery set provide different functions than Paint Pop. Applicant's "shape" has advantages and benefits as discussed below stemming from these structural and functional differences.

The Examiner further states that changing from a tray/roller to a brush/can would be obvious. Yet there is no rule that is more settled, and is more trenchant, than that which prohibits a conclusory statement of obviousness applied to the change, without pointing to the suggestion in the prior art from

which such change emanates. Is the Examiner suggesting that because a tray and roller is used to paint, and a brush and can is also used to paint, that "painting" is the suggestion? Then why not an artist's palette and paintbrush, or an air compressor and a paint spray gun? They all involve "painting." Simply because both candy products simulate different functional products used in painting does not mean that it would be obvious to change the simulated prior art painting tools to the painting tools selected by Applicant. As noted, why not other types of tools? But in any event, merely because two products simulate common utilitarian products of the same genre, does not substitute for a suggestion in the prior art that other utilitarian tools can be simulated.

But in any event, the Examiner's arguments do not come to grips with the requirement that the Examiner establish that the differences between the Paint Pop prior art and the claimed construction would have been obvious. The Examiner, when addressing this issue, states that it would be obvious to include a lid because use of a lid is a "notoriously well-known concept." To that, Applicant replies, then why does the Paint Pop product use a sachet to hold the confectionery until consumption? Applicant readily agrees that if the Paint Pop product showed a can, without a lid, then the use of a lid to enclose the contents may be "notorious." But if it is a notoriously well-known concept to place a lid on most anything, has the Examiner ever seen a paint tray with a lid? Paint trays are generally thrown out or washed out. They don't store paint. Cans with lids store paint.

The Examiner also states that the tray "essentially" contains the confection. That word is also a word of conclusion, rather than observation and analysis. As the Examiner must be aware, that statement is true only when the contents of the confectionery are deposited from the opened sachet into the paint tray during consumption. Certainly the Examiner is not suggesting that the confectionery is "essentially" contained in the paint tray at the time of sale. It is clearly contained in the plastic packet, which the Paint

Pop brochure refers to as a "sachet." The Examiner makes a point in stating that "Applicant's claim does not exclude the powder package." Applicant's Claim 28 to responds to that criticism of the Examiner.

These structural differences discussed above are not without differences in function that give rise to the benefits and advantages of Applicant's claimed invention. First, there is no plastic container or packet in Applicant's product. Therefore, separately packaging the confectionery loosely in the tray (assuming that is what the Examiner contends is the equivalent of the can) results in a product that is less expensive to manufacture. Second, once the plastic package is opened, after purchase, and upon commencement of consumption, the bell is rung. There is no way in which a partially completed consumption can be sealed or closed for both sanitary and preservation purposes. The child will empty the confectionery in the paint tray, and when all of the confectionery is not consumed, will leave the paint tray, without cover or lid, so that the consumption can be completed by ants or flies. Third, while it has been a considerable number of years since counsel for Applicant was a child, counsel's recollection, affirmed by observation of children, confirms that children cannot easily open plastic packages and pour the contents into an open container. Spills happen. Consumption is lost, or worse, the powder is scraped from the floor back into the tray. Either less fun or less hygiene.

In short, there were multiple problems involved with the Paint Pop product from the point of view of manufacture, hygienic consumption, and obtaining full enjoyment out of the product. Applicant solved these problems by avoiding what the Examiner blithely states is merely a change in shape. That is not so. The change in shape had significant benefits. It solved problems. That's what invention is all about. If the Examiner's comments belittling a change in shape and exclaiming that putting a lid on containers is notoriously obvious: Why didn't Paint Pop do that? Because it is not easy to put a lid on a tray. Because the producer of Paint Pop decided that it needed to independently package the powdered confectionery in cellophane bags, rather than in the container from which the confectionery would be consumed. Applicant

had a better idea. No more plastic bag. Place the powdered confectionery loosely in the can, and close it with a selectively engageable lid. At the time of manufacture and sale, the lid would contain the confectionery and there would be no need for a separate container such as bag. Moreover, during interrupted consumption, the lid could be replaced back onto the container so that the contents could be confined to consumption by humans.

The Examiner has stated that the Paint Pop product "is a package comprising the tray, powder and the paint roller." To the extent that Applicant did not make clear the additional component in Applicant's confectionery set, the paintbrush holder, that element has been more positively claimed in the final element of Claim 28. As the Examiner will readily acknowledge, there is no component in the Paint Pop product that is comparable to the "holder for said paintbrush." When the Paint Pop product is sold, the roller, together with the sealed packet of confectionery powder, appears to be bubble-wrapped with the tray. The tray is not a "holder." Otherwise, it cannot be a "can including a generally cylindrical container and a selectively engageable lid." And, again, this addition of the element to the confectionery set in the claimed invention is not merely a structural distinction, but one with a beneficial function. Once more, we return to mid-consumption, where it will be seen that if the confectionery is held in the paint tray, and the paint roller sucker has been, to use the colorful phrase in the Paint Pop brochure, "slurped," there is no way of hygienically protecting the wetted sucker from uninvited guests. Contrast that with the neatness and cleanliness of the claimed invention. Mid-consumption, the child having had its confectionery satiation, the edible portion of the paintbrush can be placed in the holder, with the lid then engaged on the container, and one has a nice, neat, clean mid-consumption package that only a mother could appreciate. And that's not all. It is unnecessary for Applicant to shrink-wrap or otherwise spend money on both the plastic and the labor necessary to package the components of the confectionery set. Because of the use of a can, instead of a tray, and the use of a holder, instead of nothing, the edible

portion of the paintbrush can be sealed in the holder, and the confectionery can be sealed in the can, and the whole set need not be shrink-wrapped.

Considering the elements of the structure of the claims, together with the comments pointing out not merely the structural differences, but the benefits and advantages that accrue from the configuration of the product as set forth in the claims, it is believed that Claim 27 and 28 are in condition for allowance, and the same is respectfully requested.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached paper is captioned "Version with Markings to Show Changes Made."

No fee is believed to be due in view of the previously canceled claims, however authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213. A duplicate of this paper is enclosed for accounting purposes.

We request an Examiner interview. Please call me to set up a time.

Respectfully submitted,

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Version with Markings to Show Changes Made

In the Claims:

Add the following new claim:

--28. A confectionery set comprising at least four parts;

 a paint brush having a non-edible handle portion and an edible brush portion;

 a can including a generally cylindrical container and a selectively engageable lid;

 a flowable confectionery in said generally cylindrical container at the time of sale,

 said lid engaged with said container at the time of sale so as to prevent inadvertent spilling of said confectionery, said confectionery extractable during consumption by said paint brush edible portion after disengaging said lid and said lid engageable on said container after consumption of at least a portion of said confectionery; and

 packaging comprising a holder for said paint brush, said holder attached to said can.--